

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPELANTS: P. Dubbert et al.

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**Commissioner of Patents
P.O. Box 1450
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AMENDED APPEAL BRIEF
(37 CFR 41.37(d))

This brief is in furtherance of the Notification of Non-Compliant Appeal Brief mailed December 19, 2008. In accordance with the Notice and 37 C.F.R. 41.33, Applicant has removed reference to the corresponding granted Canadian Patent Application.

The fees required under § 41.20(b)(2) and any required petition for extension of time for filing this brief and fees were previously paid. No new fees are believed to be required. Should any fees be required in conjunction with the filing of this Supplemental Appeal Brief, Commissioner is authorized to charge any additional fees or credit overpayment under 37 CFR 1.16, 1.17, or 41.20 which may be required by this paper to Deposit Account 162201.

This brief contains these items under the following headings and in the order set forth below (37 CFR 41.37 and MPEP 1208):

- I. REAL PARTY IN INTEREST
- II. RELATED APPEALS AND INTERFERENCES
- III. STATUS OF CLAIMS
- IV. STATUS OF AMENDMENTS
- V. SUMMARY OF CLAIMED SUBJECT MATTER
- VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL
- VII. ARGUMENT: REJECTIONS UNDER 35 U.S.C. §103
- VIII. CLAIMS APPENDIX
- IX. EVIDENCE APPENDIX
- X. RELATED PROCEEDINGS APPENDIX

I hereby certify that this correspondence is being transmitted via EFS-WEB to the United States Patent and Trademark Office on the date below

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December 30, 2008
Date of Signature

I. REAL PARTY IN INTEREST (37 C.F.R. 41.37 (c)(1)(i))

The real party in interest in this appeal is Kirchner Block and Brick, Inc., a Missouri Corporation, the assignee of the present application. Kirchner Block and Brick, Inc., is a wholly owned subsidiary of Midwest Products Group, Inc., a Missouri Corporation. The inventors are obligated to assign all rights in the patent application to Kirchner Block and Brick, Inc.

II. RELATED APPEALS AND INTERFERENCES (37 C.F.R. 41.37 (c)(1)(ii))

With respect to other appeals or interferences that will directly affect, or be directly affected by, or having a bearing on the Board's decision in this appeal:

- A. ☒ there are no such appeals or interferences.
B. ☐ there are as follows:

III. STATUS OF CLAIMS (37 CFR 41.37 (c)(1)(iii))

The status of the claims in this application are as follows:

A. TOTAL NUMBER OF CLAIMS IN APPLICATION

Claims in the application are: **21**

B. STATUS OF ALL THE CLAIMS

(If there are no claims in a category indicated: NONE)

1. Claims cancelled: **7 and 13-15**
2. Claims withdrawn from consideration but not cancelled: **1-6, 8-12, and 19-21**
3. Claims pending: **1-6, 8-12, and 16-21**
4. Claims allowed: **None**
5. Claims rejected: **16-18**

C. CLAIMS ON APPEAL

The claims on appeal are: **16-18**

IV. STATUS OF AMENDMENTS (37 CFR 41.37 (c)(1)(iv))

There are presently no pending unentered amendments in the above identified application.

V. SUMMARY CLAIMED SUBJECT MATTER (37 CFR 41.37 (c)(1)(v))

16. An attachment assembly (76) for securing an upright (16) of a scaffolding system (10) to a retaining wall (12) comprised of a plurality of retaining wall blocks (13); the attachment assembly (76) comprising: (p. 16 ¶ [0053], Figs. 1 and 17-19)

a standoff bracket (67) mountable to said upright (16); said standoff bracket assembly (67) comprising a base (68) adapted to be secured to said upright (16), a standoff leg (72) extending from said base (68) and an attachment dowel (74) extending from said base (68); said leg (72) engaging the retaining wall (12) in use to maintain the frame a determined distance from the wall (12); (p. 11 ¶ [0042], Figs. 12A-12B)

a flexible attachment strap (102) having a first end (102a) and a second end (102b) and being of a length sufficient to pass through said wall (12); an eyelet (104) in said first end (102a) sized and shaped to fit over said standoff assembly (67) attachment dowel (74); said attachment strap (102) including a slot (106) at its said second end (102b); (p. 14 ¶ [0050], Figs. 1 and 17-19D)

a retainer (110, 110'); said retainer (110, 110') comprising a body (112) comprising a top surface (114), a bottom surface (116), a block engaging surface (120) adapted to engage said retaining wall (12) during use, and an opening (122) in said block engaging surface (120); said retainer body (112) opening being sized to allow said attachment strap (102) to pass therethrough; said retainer (110, 110') further including a wedge (140) which is sized and shaped to be received in said attachment strap slot (102); said wedge (140) having a first side edge (Figs.

17-20) which engages a surface (130, 131, 154) of said retainer (110, 110') and a second side edge (Figs. 17-20) which engages a surface (Figs. 17-20) of said attachment strap slot (106) distal from said retainer surface (130) to urge said retainer (110, 110') against said retaining wall (12); said retainer (110, 110') cooperating with said attachment strap (102) to pull said stand-off assembly (67) toward said retainer (110, 110'), thereby urging a surface (130) of said retainer (110) and said stand-off (67) against opposite sides of said retaining wall (12) to secure the frame (Fig. 1) in position relative to the retaining wall (12). (p. 16 ¶ [0053], Figs. 17-19D)

17. The attachment assembly (76) of claim 16 wherein said retainer body (112) is generally elongate and comprises a back surface (126) spaced from said block engaging surface (120) by said top (114) and bottom surfaces (116); an opening (122) in said back surface (126) sized to allow said strap (102) to pass therethrough; and aligned slots (128) in said upper (114) and lower surfaces (116) of said retainer (110); said wedge (140) passing through said slots (128) and engaging a forward surface (130, 131) of said slots (128). (p. 14-15 ¶ [0051], Figs. 19-19D)

18. The attachment assembly of claim 17 wherein said retainer body slot forward surfaces (130, 131) are sloped; the slope of the slot surfaces (130, 131) corresponding generally to the slope of the wedge edges (Figs. 17-20). (p. 15 ¶ [0052], Figs. 19-19D)

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL (37 CFR 41.37(c)(1)(vi))

The following grounds of rejection are requested to be reviewed on appeal:

A. The Examiner's conclusion that Claims 16-18 are obvious under 35 U.S.C. §103 over U.S. Pat. No. 4,850,453 issued to *St-Germain* (hereafter referred to as "*St-Germain*") in view of U.S. Pat. No. 3,690,613 issued to *Shoemaker* (hereafter referred to as "*Shoemaker*"), and U.S. Pat. No. 3,741,516 issued to *Rugger* (hereafter referred to as "*Rugger*").

B. The Examiner's restriction of Claims 1-6, 8-12 and 19-21.

VII. ARGUMENTS - REJECTIONS UNDER 35 U.S.C. § 103 (CFR 1.192(c)(8)(iv))

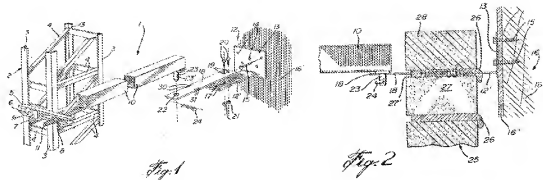
A. Introduction and Overview

The Examiner rejected Claims 16-18 under 35 U.S.C. §103(a) as being unpatentable over *St-Germain* in view of *Shoemaker* and *Rugger*. Applicants respectfully disagree with the Examiner's conclusion and suggests that the Examiner has improperly constructed a rejection with hindsight based merely on the road map provided by Applicants' specification. In addition, the Examiner has failed to provide a proper rational as to why a person of ordinary skill in the art would have combined the references in the manner claimed. Furthermore, the Examiner's proposed combination and modification of the cited references would make the prior art inventions inoperable and would change the principle of operation of the prior art inventions.

B. Discussion of the References

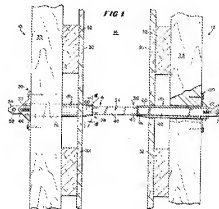
1. U.S. Pub. No. 4,850,453 to *St-Germain*.

As best understood, *St-Germain* discloses a scaffolding attachment (1), as best seen in FIGS. 1-2 which is reproduced below, having an elongated threaded rod (11) which is secured to the scaffolding by means of the flat bars (5 and 6) and a pair of nuts (8) (only one of which is shown). An rigid elongate beam (10) is welded or otherwise secured to the rod (11). The beam (10) is connected to a rigid link (18) by means of a peg (23) which extends from the beam (10) through an opening (22) in the link (18). The link (18), in turn, is mounted to a plate (12') of a bracket (12) which is fixed to a wall (16). As seen, the bracket (12) secured to the side (16') of the wall (16) adjacent the scaffolding. (*St-Germain* 3: 2-40). As can be appreciated, to maintain the scaffolding fixed in place relative to the wall 16, the rod 11, beam 10, link 18, and plate 12' all bear both compressive and tensile forces.



2. U.S. Pat. No. 3,690,613 to Shoemaker.

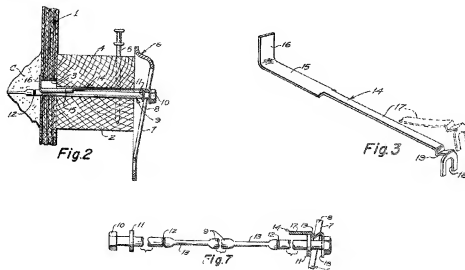
Shoemaker discloses a rod securing means for maintaining the sides of a concrete wall form (14) in place relative to each other during pouring into the form and setting of the concrete poured into the form. As seen in FIG. 1, which is reproduced below, *Shoemaker* provides a rigid tie rod (34) which extends through the opposite sides (10 and 12) of a concrete form (14). (*Shoemaker* 4: 29-41; 7:14-61). Sleeve cones (18) pass through each side of the concrete form (14), and the tie rod (34) passes through the sleeve cones (18). *Id.* Backing plates (20) are secured to the outside (back sides) of each of the sides (10 and 12) of the form (14). *Id.* The tie rod (34) passes through the plates (20). *Id.* Wedges (22) are provided which pass through slots (50) in the opposite ends of the tie rod (34), slots (80) in upturned corners of the plate (20), and slots (64) in the cone sleeve (18). *Id.*



3. U.S. Pat. No. 3,741,516 to Rugger.

Rugger discloses another concrete form securing means comprising a rigid tie rod (9) extending between a pair of forms and secured by a wedge members (6) and heads (10). (*Rugger* 2:40-66). A bendable tie strap (14) engages each end of the tie rod (9) and in conjunction with

the wedge members (6) holds the form parts in a fixed relation relative to each other. (*Rugger* 3:44-47, 54-58). FIGS. 2, 3, and 7 of *Rugger* are reproduced below:



C. Requirements For A *Prima Facie* Case Of Obviousness

As the Federal Circuit has admonished, “virtually all [inventions] are combinations of old elements.” *Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.*, 411 F.3d 1332 (Fed. Cir. 2005). Here, the Examiner apparently has attempted to find every individual element of the claimed invention in the prior art. However, “The mere fact that elements of [an invention] may be found in various [references] does not necessarily negate invention.” *In re McKenna*, 40 C.C.P.A. 937, 203 F.2d 717, 721, 97 U.S.P.Q. (BNA) 348, 351 (CCPA 1953). “Impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.” MPEP § 2142. The recent *KSR* decision has not altered these requirements.¹

As outlined in the Examination Guidelines of Federal Register, Vol. 72, No. 195, p. 57534 (October 10, 2007) and substantially adopted as MPEP §2141 (Rev. 6, 2007), the Supreme

¹ See *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 USPQ2d 1385 (2007).

Court in the *KSR* decision reaffirmed the framework for determining obviousness under 35 U.S.C. §103(a) as set forth in *Graham v. John Deere Co.*² Under the *Graham* decision, this framework includes:

- (a) ascertaining the scope and contents of the prior art;
- (b) ascertaining the differences between the prior art and the claims in issue; and
- (c) resolving the level of ordinary skill in the pertinent art.³

As noted in the Examination Guidelines, the *KSR* Court “recognized that a showing of ‘teaching, suggestion, or motivation’ to combine prior art to meet the claimed subject matter could provide a helpful insight in determining whether the claimed subject matter is obvious under 35 U.S.C. 103(a).”⁴ As further outlined in MPEP §2141, the *KSR* Court noted that the “analysis supporting a rejection under 35 U.S.C. § 103(a) should be made explicit and that it is ‘important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] element’” in the manner claimed. The Court specifically stated:

“it will often be necessary to look to interrelated teachings of multiple patents; to the effects of demands known to the design community or present in the marketplace; and to the background knowledge possessed by a person having ordinary skill in the art. To facilitate review, this analysis should be made explicit.” *KSR*, at 1731.

MPEP §2141 concludes in its analysis of the *KSR* decision that “in formulating a rejection under 35 U.S.C. §103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed”. As the Federal Circuit has found, “a flexible TSM test remains

² See 383 U.S. 1 (1966).

³ See *Graham v. John Deere*, 383 U.S. 1, 17-18 (1966).

the primary guarantor against a non-statutory hindsight analysis.” *Ortho-McNeil Pharmaceutical, Inc. v. Mylan Laboratories, Inc.*, 520 F.3d 1358, 1364 (Fed. Cir. 2008) (citing *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007)(“[A]s the Supreme Court suggests, a flexible approach to the TSM test prevents hindsight and focuses on evidence before the time of the invention.”)). The *Ortho* court states that the “TSM test, flexibly applied, merely assures that the obviousness test proceeds on the basis of evidence – teachings, suggestions (a tellingly broad term), or motivations (an equally broad term) that arise before the time of the invention as the statute requires.” *Id.*

35 U.S.C §103(a) still requires that “[a] patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.”(emphasis added). Applicants respectively suggest that the Examiner has disregarded the “subject matter as a whole” language of the statute. Nothing in the art of record shows describes or even vaguely intimates the “subject matter as a whole” of Applicants’ structural combination set forth in the claims 16-18. Rather, apparently using Applicants’ specification as a guide, the Examiner has improperly constructed the rejection element by element. Furthermore, under this improper construction, the Examiner’s rejections are silent as to why a person of ordinary skill in the art would have combined the references as the manner claimed.

⁴ Federal Register, Vol. 72, No. 195, p. 57534 (October 10, 2007)(emphasis added).

D. Claims 16-18 Are Patentable Over The *St-Germain*, *Shoemaker*, and *Rugger* Patents.

In his rejection of Claims 16-18, the Examiner asserts that *St-Germain* shows standoff bracket (Fig. 1; 5-9), a standoff leg (10), and a dowel (23). The Examiner admits that *St-Germain* does not disclose an attachment strap or a retainer body. (6/18/07 Office Action, pg. 2; and 3/03/08 Office Action, pg. 2-3). Instead, the Examiner cites *Shoemaker* as teaching an attachment strap (Fig. 1; 34) with an eyelet (22), a retainer body (20) with slotted walls (78), and a wedge (22). *Id.* Furthermore, the Examiner cites *Rugger* as showing an attachment strap made from a flexible material. *Id.* Without providing any proper rationale, the Examiner concludes that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to form the scaffolding attachment of *St-Germain* to have the attachment strap (34) and body (20) as taught by *Shoemaker*. *Id.* Moreover, the Examiner asserts that it would have been obvious in light of *Rugger* for the attachment strap to be made of a flexible material. *Id.* Further, the Examiner contends that it would have been an “obvious engineering expediency” to slope the surface of the slots to correspond to the slope of the wedge without providing any evidentiary support. *Id.* Applicants respectfully disagree with the Examiner’s combination of *St-Germain*, *Shoemaker*, and *Rugger*.

A look at the cited references clearly shows that it would not have been obvious to combine *St-Germain*, *Shoemaker*, and *Rugger*. To start, neither *St. Germain*, *Shoemaker*, nor *Rugger* teach, suggest or, disclose the use of either a flexible attachment strap or a standoff as set forth in Claim 16. In addition, the cited references do not contain any suggestion to combine the elements cited by the Examiner, but instead teach away from such a combination. See *Ted Air, Inc. v. Denso Manufacturing Michigan, Inc.*, 192 F.3d 1353 (Fed. Cir. 1999)(“There is no

suggestion to combine ... if a reference teaches away from its combination with another source ...”).

Specifically, nothing in *Shoemaker* discloses or suggests a flexible attachment strap. Rather, *Shoemaker* teaches that a rigid tie rod is required to handle compression forces, stating, “In this connection, the tie rod must be strong enough to assimilate the large stresses which are imposed upon it during pouring of wet concrete...” (*Shoemaker* 1:47-51).

Similarly, *Rugger* shows a rigid tie rod and tie strap that must handle compression forces. *Rugger* states, “The tie rods and the tie straps 14 in conjunction with the wedge hold the plywood panels in predetermined fixed relation ready to receive concrete.” (*Rugger* 3:44-46). Although not expressly stated by the Examiner, it appears that the Examiner erroneously equates tie strap (14) with the claimed flexible attachment strap. (3/03/08 Office Action, pg. 2). The specification of *Rugger* discloses the tie strap (14) is “formed of spring steel” so that it “may be bent elastically as indicated by dotted lines in Fig. 3”. Clearly, a stiff but ductile spring steel that is required to handle compression forces does not equate to the claimed flexible attachment strap. Applicants’ specification is not consistent with such an interpretation of the term “flexible”, which states “The strap 102 is preferably formed from a material so that it will be flexible. A preferred material is a plastic, such as nylon.” (Application, ¶0050). The specification also teaches away from the use of metal for the strap, stating, “A metal strap will rust, and the rust will stain the wall 12.” (Application, ¶0056). A plastic material, such as nylon, can not support the compression forces disclosed in either *Rugger* or *Shoemaker*.

As submitted in Applicants’ remarks from the Amendment filed December 14, 2007, if the tube (10) or rigid link (18) of *St-Germain* were replaced with a flexible strap, the scaffolding

of *St-Germain* would become inoperative and would change the principle of its operation.⁵ The replacement of these rigid members with a flexible member would allow for the scaffolding of *St-Germain* to move relative to the bracket (12) and wall (16). Applicants' attachment system avoids this problem by passing the strap through the wall, and then pulling the strap taut with the retainer. (Application, ¶0053). As can be appreciated, this pulls the standoff and the retainer against opposite sides of the wall to secure the frame of the fall protection system in place relative to the wall. *Id.* However, in response to Applicants' remarks from the Amendment filed December 14, 2007 the Examiner stated:

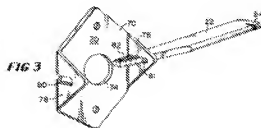
"Applicant's arguments filed 12/14/07 have been fully considered but they are deemed not persuasive. Applicant argues that to use a flexible strap with the standoff bracket of St. Germain would be inoperative, the examiner disagrees, the flexible strap is capable of being attached to the dowel of St. Germain and further be capable of being passed through a wall. With respect to Claim 18, note the body of the rejection above."

In light of this statement, it appears the Examiner did not fully comprehend Applicants' remarks. What Applicants were asserting in the arguments filed 12/14/07 was that the Examiner's proposed modification to *St-Germain* (i.e., replacement of the rigid beam (10) and the rigid link member (18) with a flexible member) would render the device of *St-Germain* inoperable and would change the principle of operation. Specifically, *St-Germain* only discloses the use of the rigid beam (10), rigid link (18), and rigid plate 12' to connect the scaffolding to the wall (16). As seen in FIGS. 1-2 of *St-Germain*, the rigid plate (21') is secured to the surface of the wall (16) adjacent to the scaffolding. None of the beam, link or plate which secure the scaffolding in place relative to the wall (16) pass through the wall (16). If this rigid connection

⁵ MPEP § 2143.01, "If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

between the scaffolding and wall (16) were replaced with a flexible member, as suggested by the Examiner, the scaffolding would become unstable. Unstable scaffolding is dangerous, and hence unusable (or inoperative). Because *St-Germain* does not teach any other method to stabilize the scaffolding (such as the use of a separate standoff assembly extending between the scaffolding and the wall as set forth in the claims of this application), the modification suggested by the Examiner renders the *St-Germain* scaffolding inoperative.

Furthermore, with respect to Claim 18, none of the references teach or suggest that the slot in the retainer body (which is aligned with the attachment strap slot) has a sloped surface, and that the slope of this surface corresponds to the slope of the wedge. While the wedge bolt (22) of *Shoemaker* does have a sloped surface, the slots (80) in the plate (20) through which the wedge bolt passes are both of equal size, as seen in FIG. 3, which is reproduced at the right. As seen, the slots (80) of *Shoemaker's* plate (20) do not define a sloped surface.



In the Office Action of June 18, 2007, the Examiner rejected Claims 16-18 under 35 U.S.C. §103 as being unpatentable over *St-Germain* in view of *Shoemaker*. In response to Applicants' Reply of September 18, 2007, the Examiner entered the present rejection. Hence, by now rejecting Claims 16-18 over *St-Germain* in view of *Shoemaker* and *Rugger*, the Examiner has essentially conceded that *St-Germain* and *Shoemaker* do not make the Claims 16-18 obvious.

As set forth in the September 18, 2007 response at page 13, "neither *St-Germain* nor *Shoemaker* disclose the use of a flexible strap or standoff as currently set forth in Claim 16." The Examiner now asserts that *Rugger* discloses that missing flexible strap. But all the Examiner

appears to do is replace the rigid link of *St-Germain* with the flexible strap as discussed above, which would render the *St-Germain* scaffolding inoperative.

Also, the Examiner asserts that it would have been an “obvious engineering design expediency” to slope the surface of the slots to correspond to the slope of the wedge. However, this assertion lacks any evidentiary support because none of the cited references disclose, teach, or suggest the surface of the slots corresponding to the slope of the wedge. Rather, the Examiner relies on his own personal knowledge and the general knowledge in the prior art to support his obviousness rejection. The Examiner’s ability to use such personal and general knowledge is subject to 37 CFR §1.104(d)(2), which states:

“When a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by an affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons.” See 37 CFR §1.104(d)(2).

Even after Applicants’ request under 37 CFR §1.104(d), the Examiner did not provide an affidavit in conformance with §1.104(d)(2). As expressly recognized in MPEP 2144.03, “It is never appropriate to rely solely on ‘common knowledge’ in the art without evidentiary support in the record, as the principle evidence upon which a rejection was based.” Applicants point out that general skill in the art will rarely operate to supply missing knowledge or prior art to reach an obviousness judgment. As stated by the Federal Circuit:

“To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.” See *W.L. Gore & Assocs. V. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984); *In re Sang Su Lee*, 277 F.3d 1338, 1344 (Fed. Cir. 2002).

As noted above, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed. *See KSR* at 1731. Here, the Examiner has failed to provide a rationale for combining the cited references. To support the conclusion that the claimed invention is directed to obvious subject matter “the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” MPEP §706.02(j), citing *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

The Examiner’s only explanation for combining the references is to simply identify the purpose of the element. For example, the Examiner’s stated rationale for providing the attachment member of *St-Germain* with flexible material of *Rugger* is “to enable a flexible attachment member that is capable of being used with his standoff bracket and being capable of attaching to the wall”. (3/03/08 Office Action, pg. 2). However, these statements merely identify the purpose of each individual elements. They do not illustrate a suggestion, teaching, or motivation to combine the elements.

Further, Applicants respectfully submit that the Examiner is not using the correct standard in determining making the proposed combination. The Examiner is using an “if the modification can be made” standard. The correct standard is if the proposed modification would be *obvious* to one of skill in the art. 35 U.S.C. 103.⁶ As discussed above, the Examiner’s proposed modification would replace a rigid member extending between the scaffolding and the wall surface adjacent the scaffolding with a flexible member. Because the flexible member will bend

⁶ 35 USC 103 states that “a patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole *would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.*” (emphasis added).

or flex under the compressive loads that will be applied during use, the scaffolding will be able to swing to and fro relative to the wall, rendering the scaffolding unstable, and thus dangerous to use. One skilled in the art would not make a modification that would render scaffolding unstable. Hence, the Examiner's proposed modification would not be obvious to one of skill in the art.

In view of the arguments above, Applicants respectfully submit that Claim 16 is allowable over both *St-Germain*, *Shoemaker*, and *Rugger* whether considered individually or in combination. Claims 17-18 depend from Claim 16 and hence incorporate all the elements of Claim 16. Claim 17-18 are thus believed to be allowable for the same reasons set forth above with respect to Claim 16. Applicants thus request that the Examiner's rejection of Claims 16-18 be reversed.

E. Restriction of 1-6, 8-12, and 19-21

Applicants respectfully traverse the restriction requirement for Claims 1-6, 8-12 and 19-21 and submit that the restriction requirement is not proper. In support of this, Applicants note that the second restriction requirement (issued on November 19, 2007) is nearly identical to the first restriction requirement (issued on March 8, 2007). In support of the present restriction requirement, the Examiner stated:

"Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination does not require a strap fitting over a standoff dowel. The subcombination has separate utility such as an attachment for wedging a pair of wooden plank together."

Except for the underlined verbiage, this statement is identical to the statement made in support of the first restriction requirement. The underlined verbiage was not present in the justification for the original restriction requirement. In response to the first restriction requirement, Applicants elected Group II (Claims 13-19, as set forth in that restriction requirement) and amended the claims. In response to the amendment filed with the restriction requirement, the Examiner withdrew only Claims 12 and 19.

In a telephone call with the Examiner, the Examiner asserted that the addition of new Claim 21 in the amendment filed September 18, 2007 effectively mooted the prior restriction requirement, thereby requiring entry of this new restriction requirement. Applicants, however, note that new Claim 21 is a dependent claim which depends from Claim 3 and sets forth features of the attachment assembly mounting portion and the gravity pin.

Applicants point out that Claim 1 is directed to a retaining wall fall protection system including an attachment assembly. Claim 16 (the other independent claim) is directed to the attachment assembly itself. The attachment assembly as set forth in Claim 1 includes all the elements as the attachment assembly as set forth in Claim 16. With respect to the Examiner's distinction (noted above), Applicants note that Claim 1 states that the "attachment strap [is] connected at said first end to said stand-off assembly". Claim 16, on the other hand provides the attachment strap includes "an eyelet in said first end sized and shaped to fit over said standoff assembly attachment dowel". Thus, Claim 16 defines the attachment strap more narrowly than Claim 1. Because Claim 16 includes the attachment assembly of Claim 1, Applicants respectfully assert that Claim 16 is not a subcombination of Claim 1.

Applicants respectfully request that the Board reverse the Examiner's restriction requirement of Claims 1-6, 8-12 and 19-21.

F. Conclusion

As discussed above, the references fail to disclose the noted elements of the claims, and hence, in accordance with the requirements of the MPEP, as set forth in Chapter 2100 the references cannot make the claims obvious. Further, as noted above, in particular instances, the Examiner failed to make *prima facie* showings of obviousness or otherwise improperly interpreted or applied the disclosure of the cited patents.

As discussed above, Claims 16-18 are allowable over *St-Germain*, *Shoemaker*, and *Rugger*, whether considered individually or in combination. Applicants thus respectfully request that the Board reverse the Examiner's rejections of Claims 16-18. Also, Applicants respectfully request that the Board reverse the Examiner's restriction of Claims 1-6, 8-12 and 19-21.

Respectfully submitted,

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VIII. CLAIMS APPENDIX (37 CFR 41.37 (c)(1)(vii))

The text of the claims in the appeal are:

1. (Withdrawn) A retaining wall fall protection system comprising:

a frame comprised of a plurality of base plates; a plurality of uprights connectable to the base plates; and cross-braces and or guard rails mountable between adjacent uprights;

a stand-off assembly mounted to said uprights and having a standoff leg adapted to maintain a predetermined distance between the retaining wall and the uprights; and

an attachment assembly attachable to the stand-off assembly and adapted to engage the retaining wall to temporarily fix said frame to the retaining wall; said attachment assembly comprising a flexible attachment strap and a retainer; said attachment strap having a first end and a second end; said attachment strap being connected at said first end to said stand-off assembly; said attachment strap being sized to extend through said wall; said retainer engaging said attachment strap on a side of said wall opposite said frame to place a tensile stress on said attachment strap, thereby pulling said stand-off assembly, and hence said frame, against said wall, thereby securing said frame in place relative to said wall.

2. (Withdrawn) The retaining wall fall protection system of claim 1 further comprising a leveling adjustment screw pivotally attached to each base plate and having a leveling adjustment nut threaded thereon for supporting said upright; each said leveling adjustment nut receiving a bottom end of one of said uprights.

3. (Withdrawn) The retaining wall fall protection system of claim 1 comprising a coupling tube for connecting segments to form an upright of a desired height; said coupling tube having a width, a height, and a length; the width of said coupling tube being smaller at opposite ends of said coupling tube than at a middle of said coupling tube.

4. (Withdrawn) The retaining wall fall protection system of claim 1 comprising a guardrail bracket mountable to the upright; said guardrails being mountable to said guardrail bracket.

5. (Withdrawn) The retaining wall fall protection system of claim 4 wherein said guardrail bracket comprises a base mountable to the upright and at least one toggle pin extending from the guardrail bracket base; said guardrail comprising an opening at at least one end thereof which is sized to fit over said toggle.

6. (Withdrawn) The retaining wall fall protection system of claim 1 wherein the standoff assembly comprises a base adapted to be secured to said upright; said standoff leg extending from said base, and an attachment dowel extending from said base;

said attachment assembly comprising an attachment strap having a first end and a second end; an eyelet in said first end sized and shaped to fit over said standoff assembly attachment dowel.

7. (Cancelled)

8. (Withdrawn) The retaining wall fall protection system of claim 6 wherein said retainer cooperating with said attachment strap to urge a surface of said retainer against a back surface of said retaining wall.

9. (Withdrawn) The retaining wall fall protection system of claim 8 wherein said attachment strap includes a slot at its said second end; said retainer comprising a body comprising a top surface, a bottom surface, a front face surface adapted to engage said retaining wall, and an opening in said front face surface; said retainer body opening being sized to allow said attachment strap to pass therethrough; said retainer further including a wedge which is sized and shaped to be received in said attachment strap slot; said wedge engaging a surface of said

retainer and an edge of said attachment strap slot distal from said retainer surface to urge said retainer against said retaining wall.

10. (Withdrawn) The retaining wall fall protection system of claim 9 wherein said retainer body is generally elongate and comprises a back surface spaced from said front surface by said top and bottom surfaces; an opening in said back surface sized to allow said strap to pass therethrough; and aligned slots in said upper and lower surfaces of said retainer; said wedge passing through said slots and engaging a forward surface of said slots.

11. (Withdrawn) The retaining wall fall protection system of claim 10 wherein said retainer body slot forward surfaces are sloped; the slope of the slot surfaces corresponding generally to the slope of the wedge edges.

12. (Withdrawn) The retaining wall fall protection system of claim 9 wherein the block used to construct the wall is an open block having a horizontal surface extending between side surfaces; the retainer body being generally C-shaped and comprising an upper surface, a lower surface and a back wall; the forward surface of said back wall defining said retainer front face; said back wall having a height greater than the width of said block horizontal surface; said front face opening being positioned adjacent said retainer bottom surface.

13. (Cancelled)

14. (Cancelled)

15. (Cancelled)

16. (Rejected) An attachment assembly for securing an upright of a scaffolding system to a retaining wall comprised of a plurality of retaining wall blocks; the attachment assembly comprising:

a standoff bracket mountable to said upright; said standoff bracket assembly comprising a base adapted to be secured to said upright, a standoff leg extending from said base and an attachment dowel extending from said base; said leg engaging the retaining wall in use to maintain the frame a determined distance from the wall;

a flexible attachment strap having a first end and a second end and being of a length sufficient to pass through said wall; an eyelet in said first end sized and shaped to fit over said standoff assembly attachment dowel; said attachment strap including a slot at its said second end;

a retainer; said retainer comprising a body comprising a top surface, a bottom surface, a block engaging surface adapted to engage said retaining wall during use, and an opening in said block engaging surface; said retainer body opening being sized to allow said attachment strap to pass therethrough; said retainer further including a wedge which is sized and shaped to be received in said attachment strap slot; said wedge having a first side edge which engages a surface of said retainer and a second side edge which engages a surface of said attachment strap slot distal from said retainer surface to urge said retainer against said retaining wall; said retainer cooperating with said attachment strap to pull said stand-off assembly toward said retainer, thereby urging a surface of said retainer and said stand-off against opposite sides of said retaining wall to secure the frame in position relative to the retaining wall.

17. (Rejected) The attachment assembly of claim 16 wherein said retainer body is generally elongate and comprises a back surface spaced from said block engaging surface by said top and bottom surfaces; an opening in said back surface sized to allow said strap to pass therethrough; and aligned slots in said upper and lower surfaces of said retainer; said wedge passing through said slots and engaging a forward surface of said slots.

18. (Rejected) The attachment assembly of claim 17 wherein said retainer body slot forward surfaces are sloped; the slope of the slot surfaces corresponding generally to the slope of the wedge edges.

19. (Withdrawn) The attachment assembly of claim 16 wherein said retainer is generally C-shaped and comprises an upper surface, a lower surface and a back wall; the forward surface of said back wall defining said block engaging surface; said back wall having a height greater than the width of said block horizontal surface; said opening being positioned adjacent said retainer bottom surface.

20. (Withdrawn) A retaining wall fall protection system comprising:
a frame comprised of a plurality of base plates; a plurality of uprights connectable to the base plates; and cross-braces and/or guard rails mountable between adjacent uprights;
a stand-off assembly mounted to said uprights and having a standoff leg adapted to maintain a predetermined distance between the retaining wall and the uprights; and
an attachment assembly attachable to the stand-off assembly and adapted to engage the retaining wall to temporarily fix said upright to the retaining wall; said attachment assembly comprising:

a flexible attachment strap having a first end and a second end; said strap being adapted at said first end to be removably connected to said standoff assembly said attachment strap being of a length sufficient to pass through said wall; said attachment strap including a slot at its said second end;

a retainer; said retainer comprising a body having a block engaging surface adapted to engage said retaining wall, an opening in said block engaging surface, opposed first and second surfaces extending from said block engaging surface, and aligned slots

extending inwardly from a back of said surfaces, said slots being opened at said back surface of said back of said surfaces; said retainer body opening being sized to allow said attachment strap to pass therethrough; and

a wedge sized and shaped to be received in said attachment strap slot and said slots of said retainer surfaces; said wedge having a first side edge which engages an inner surface of said retainer slots and a second side edge which engages a surface of said attachment strap slot distal from said retainer surface, whereby, said wedge cooperates with said attachment strap to pull said stand-off assembly and said retainer against opposite sides of said retaining wall to secure said frame in position relative to said retaining wall.

21. (Withdrawn) The retaining wall fall protection system of claim 3 wherein said coupling tube and said uprights have openings which pass therethrough, the holes of the coupling tube being aligned with the holes in the uprights; said fall protection system further comprising a gravity pin; the gravity pin 46 comprising an L-shaped mounting portion and a generally U-shaped portion;

said mounting portion comprising a first leg and a second leg; said first leg being sized and shaped to extend through the aligned holes of the upright and coupling tube such that said gravity pin can rotate relative to said uprights; said second leg extending generally perpendicularly from an end of said first leg;

said U-shaped portion extending from an end of the mounting portion second leg and being in a plane generally perpendicular to the plane of the mounting portion; said U-shaped portion comprising a pair of short legs joined by a member;

said gravity pin being rotatable relative to the upright between a raised position in which the mounting portion first leg can be passed through or removed from the aligned holes of the upright and the coupling tube and a lowered position in which the U-shaped section member rests against said upright and said U-shaped section legs extend along opposite sides of the upright to prevent the gravity pin mounting section first leg from exiting said aligned holes of the upright and coupling tube.

IX. EVIDENCE APPENDIX (37 CFR 41.37 (c)(1)(ix))

Not applicable

X. RELATED PROCEEDINGS APPENDIX (37 CFR 41.37 (c)(1)(x))

Not applicable.

Respectfully submitted,

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